

REMARKS

Claims 1-6, 8-13, and 15-22 were pending in the application prior to this amendment. Claims 15-20 have been canceled without prejudice. Claims 23 and 24 were added. Specifically, claims 23 and 24 are “article of manufacture” claims based on claims 1 and 5, respectively. These newly added claims use the same language as their respective originating claims and, as such, are merely different version of the same claims. Therefore, Applicant respectfully submits that the amendment does not introduce any new issues. These newly added claims also comply with the requirement of form expressly set forth in the Final Office Action. Final Office Action, p. 8. Accordingly, Applicant respectfully requests that the amendment be entered. Upon entry of this amendment, claims 1-6, 8-13, and 21-24 will be pending.

I. OBJECTION TO THE SPECIFICATION

The specification stands objected to as allegedly “failing to provide proper antecedent basis” for the “computer-readable storage device” previously recited in claim 15. Final Office Action, p. 8. Applicant respectfully traverses. However, in an effort to expedite prosecution of this case, Applicant has canceled claim 15 and the objection is now moot. Furthermore, as noted above, new claim 23 adopts the language suggested by the Examiner. Therefore, Applicant respectfully requests that the objection be withdrawn.

II. CLAIM REJECTIONS UNDER § 102 OVER *GUEDALIA*

The Office Action rejects claims 1-6, 8-13, 21, and 22 under 35 U.S.C. § 102(e) over *Guedalia* (6,536,043). Applicant respectfully traverses. Furthermore, Applicant does not concede that *Guedalia* is prior art with respect to this application and reserves the right to submit materials to antedate this reference at a later time.

A. Claims 1-6, 21, 23, and 24

1. Guedalia does not teach or suggest “a processing element ... configured to monitor traffic”

Claim 1 recites “a processing element ... configured to monitor traffic” Applicant maintains that *Guedalia* does not disclose this element. The Final Office Action admits “the term ‘traffic’ [] itself does not appear” in *Guedalia*. Final Office Action, p. 3. Although the Final Office Action does not point to any specific portion of that reference that describes the monitoring of traffic, the rationale for the rejection is summarized as follows:

[*Guedalia*] teaches monitoring traffic because it clearly teaches all the partial frames do not arrive at once, but gradually or one at a time and the user does not have to wait till all the data to arrive at once. Streaming traffic is controlled or monitored and the image quality is enhanced gradually.

Office Action, p. 4. In other words, the Final Office Action contends that, because *Guedalia*’s “partial frames” arrive “one at a time,” *Guedalia*’s system must also “monitor traffic.” However, just because data does not arrive at once, it does not logically follow that traffic must be monitored. To the contrary, in *Guedalia*, “an extent of a first frame” is determined, if at all, based on a user-selected bandwidth, not on monitored traffic. *E.g.*, *Guedalia*, 34:7-11 (“The original multimedia data file 73 is input to a compressor 107 along with the user-selected control parameters 106, resulting in compressed data 108 adapted to a user-selected bandwidth.” (emphasis added)).

The Final Office Action also states that “[*Guedalia*] is capable of ... monitoring traffic, and therefore it meets the claimed limitation.” Final Office Action, p. 6. From the outset, Applicant notes that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Merely asserting that *Guedalia* “is capable of” performing a certain operation does not establish that the *Guedalia* discloses that operation, and therefore a *prima facie* rejection under 35 U.S.C. § 102(e) has not been established. Also, that the Final Office Action asserts that *Guedalia* “is capable” of monitoring traffic appears to be an admission that *Guedalia* does not in fact monitor traffic.

Furthermore, the feature of “monitoring traffic” is not inherent in *Guedalia*. “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” M.P.E.P. § 2112(IV) citing *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993). “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Id.* citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). In this case, the Final Office Action has not provided a reasoning why traffic monitoring would “necessarily flow” from *Guedalia*’s techniques. Indeed, *Guedalia* specifically discloses that its frames are determined, if at all, based on a user-selected bandwidth, not monitored traffic. *See, e.g., Guedalia*, 34:7-11.

Again, *Guedalia* does not describe “monitoring traffic.” Therefore, *Guedalia* does not teach or suggest “a processing element ... configured to monitor traffic between the storage medium and the processing element,” as recited in claim 1.

2. *Guedalia* does not teach or suggest that “the processing element is configured to dynamically determine, based at least in part on the monitored traffic, an extent of a first frame in the first progressively-encoded video stream”

Claim 1 recites that “the processing element is configured to dynamically determine, based at least in part on the monitored traffic, an extent of a first frame in the first progressively-encoded video stream.” Applicant maintains that, in *Guedalia*, “an extent of a first frame” would be determined, if at all, based on a user-selected bandwidth. *E.g., Guedalia*, 34:7-11 (“The original multimedia data file 73 is input to a compressor 107 along with the user-selected control parameters 106, resulting in compressed data 108 adapted to a user-selected bandwidth.” (emphasis added)). In fact, the Final Office Action appears to admit that, in *Guedalia*, it is the user that selects the bandwidth. *See, e.g., Final Office Action*, p.3 (“[*Guedalia*] operates by receiving the viewing parameters from the user”); p. 4 (“Hence, even if the user selects low bandwidth”). As such, according to *Guedalia*, “[t]he compressed data is transmitted to the progressive scalable database 75 as the second data block 76, and the loop continues repeatedly until the user-selected final quality is achieved.” *Guedalia*, 34:20-23.

In short, *Guedalia*'s data transmission is determined based on a user-selected bandwidth, and it is not "dynamically determined, based [on] monitored traffic." Therefore, *Guedalia* does not teach or suggest that "the processing element is configured to dynamically determine, based at least in part on the monitored traffic, an extent of a first frame in the first progressively-encoded video stream," as in claim 1.

Therefore, Applicant respectfully submits that claim 1 is patentably distinct over *Guedalia*. Claims 2-6 and 21 depend from claim 1 and thus are patentably distinct over *Guedalia* for at least the same reasons. The same arguments apply to claims 23 and 24. Accordingly, Applicant respectfully requests that the 35 U.S.C. § 102(e) rejection of claims 1-6, 21, 23, and 24 be withdrawn.

B. Claims 8-13 and 22

1. *Guedalia* does not teach or suggest "in response to detecting a pause in displaying the first frame, receiving an additional portion of the frame data for the first frame"

Claim 8 recites, in part, "in response to detecting a pause in displaying the first frame, receiving an additional portion of the frame data." Applicant maintains that *Guedalia* does not disclose this element. The Final Office Action admits "the term 'pause' is not in the reference." Final Office Action, p. 4. Nonetheless, the Final Office Action states that "[*Guedalia*] teaches the bitmap being displayed [is] enhanced as additional partial frames stream in." Final Office Action, p. 6. As previously noted, *Guedalia*'s "client ... can continue downloading [data] in background ... and thereby achieve [better quality] the next time the media is **replayed**." *Guedalia*, 21:41-46 (emphasis added). Therefore, while *Guedalia* may disclose allegedly modifying media when media is "replayed," it does not disclose "in response to detecting a pause in displaying the first frame, receiving an additional portion of the frame data," as recited in claim 8.

Unable to find any mention in *Guedalia* of "detecting a pause in displaying the first frame," the Final Office Action cites to paragraph [0041] of Applicant's specification for the

proposition that “[t]he ‘pause’ function according to the specification is not performed using a remote control ‘pause’ button to pause the picture being displayed.” *Id.* at 5. As a threshold matter, Applicant notes that neither claim 8 nor paragraph [0041] of Applicant’s specification recites a “remote control pause button.” Furthermore, contrary to the Final Office Action’s allegations, paragraphs [0040] and [0041] of the specification clearly state that, “[i]n the course of editing, there may be times during which one or more of the video streams is paused When this is the case, a paused image will gradually improve its appearance on the display 36 as additional portions of the frame data representing the image are provided to the display 36.” Specification, ¶¶ [0040]-[0041] (emphasis added). Again, *Guedalia* does not teach or suggest, “in response to detecting a pause in displaying the first frame, receiving an additional portion of the frame data,” as recited in claim 8.

The Final Office Action continues to cite to col. 26, lines 30-45 of *Guedalia* as allegedly “referring to the detection of a pause.” Final Office Action, p. 6. As noted in Applicant’s previous response, however, the cited passage only provides that:

Whenever the user re-traces steps [*i.e.*, “replays”], so that the viewing parameters are the same as those selected at some previous stage, the server does not need to render the same bitmaps again. Rather, the streaming simply continues in background, and the quality of the image on the client side is enhanced as additional partial frames are integrated.

Guedalia, 26:29-35. Again, this passage refers to “re-trac[ing] steps,” not “pausing” a display.

The Final Office Action also states that “[*Guedalia*] is capable of performing [a] pause function ..., and therefore it meets the claimed limitation.” Final Office Action, p. 6. From the outset, Applicant notes that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Merely asserting that *Guedalia* “is capable of” performing a certain operation does not establish that the *Guedalia* discloses that operation, and therefore a *prima facie* rejection under 35 U.S.C. § 102(e) has not been established. Also, that the Final Office Action asserts that *Guedalia* “is capable” of detecting a pause appears to be an admission that *Guedalia* does not in fact detect a pause.

Furthermore, the feature of “detecting a pause” is not inherent in *Guedalia*. “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” M.P.E.P. § 2112(IV) citing *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993). “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Id.* citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). In this case, the Final Office Action has not provided a reasoning why “receiving an additional portion of the frame data” “in response to detecting a pause in displaying [a] frame” would “necessarily flow” from *Guedalia*’s techniques. Indeed, *Guedalia*’s playback is enhanced, if at all, “the next time the media is replayed,” not in response to detecting a pause in displaying a frame. *See, e.g., Guedalia*, 21:41-46.

Again, *Guedalia* does not describe “detecting a pause.” Therefore, *Guedalia* does not teach or suggest “in response to detecting a pause in displaying the first frame, receiving an additional portion of the frame data,” as recited in claim 8.

Applicant respectfully submits that claim 8 is patentably distinct over *Guedalia*. Claims 9-13 and 22 depend from claim 8 and thus are patentably distinct over *Guedalia* for at least the same reasons. Accordingly, Applicant respectfully requests that the 35 U.S.C. § 102 rejection of claims 8-13 and 22 be withdrawn.

CONCLUSION

Applicant respectfully submits the application is in condition for allowance, and an early notice to that effect is requested.

If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above-referenced application from becoming abandoned, Applicant hereby petitions for such extension.

The Commissioner is authorized to charge any fees that may be required, or credit any overpayment, to Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. Deposit Account No. 501505/5957-63700/LVP.

Respectfully submitted,

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By: /Luiz von Paumgarten/
Luiz von Paumgarten
Reg. No. 52,330

Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C.
P. O. Box 398
Austin, Texas 78767
(512) 853-8863